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| 09/718,071 | 11/21/2000 | Jay C. Hsu | KCX-359 (15169) | 1979 |

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

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8

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 09/718,071 | Applicant(s) HSU ET AL. | |
| | Examiner Lauren Q Wells | Art Unit 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-17,19-22,24-27,29-40 and 42-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-17,19-22,24-27,29-40 and 42-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4, 7-17, 29-22, 24-27, 29-40, 42-49 are pending. The Amendment filed April 23, 2002, cancelled claims 5-6, 18, 23, 28, and 41, amended claims 1, 4, 7, 9, 14, 16, 22, 24-25, 30, 35, 42-43, and added claims 44-49.

Response to Arguments

Applicant's arguments, filed April 23, 2002, Paper No. 7, with respect to claims 1-43 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting Rejection Maintained

The rejection of claims 1-6, 11, 14-22, 26-27, 2-36, and 38-40 under the judicially created doctrine of double patent as being unpatentable over claims 1-3, 6, 8, 10-12, 14-17, 27-31, 34, 36, 38-40, 42 and 43-44 of copending Application No. 09/717939 is MAINTAINED for the reasons set forth in the Office Action mailed January 16, 2002, Paper No. 5.

The Applicant's comments regarding this rejection are not noted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 4, 7, 9, 11-13, 19, 22, 34, 25, 29, 30, 34-38, 42 and 44-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The rejection of the phrase "add-on-level" in claims 1, 19, 22, 29, 30, and 42 is maintained. The argument that "this phrase is expressly defined in the specification as the 'weight of a paper product treated with claims'", is not persuasive, as the meaning of this phrase is still unknown.

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(ii) The rejection of claims 1, 11, 12, 22, 30, 36 and 37 over the phrase “viscosity modifier” is maintained. This is a relative term that is not adequately described in the specification and would not be known to one of ordinary skill in the art. While Applicants have pointed out one thing that the viscosity modifier can be, a thickener, it is still not known what else the viscosity modifier can be.

(iii) The rejection of claims 1, 13, 22, 30 and 38 over the phrase “liquid-coupling component” is maintained. Applicant argues, “the specification states that the liquid coupling agents “couple” the ingredients of the composition together to ensure that the lotion composition does not separate into more than one liquid phase”. This argument is not persuasive, as it is still not clear what it means to couple ingredients together.

(iv) The phrase “said paper product being selected from the group consisting of towels, wipes, and napkins, said paper product comprising. . .” in claim 1 (lines 2-3) is vague and indefinite, as it is confusing. How can the paper product be a towel, wipe or napkin, and be a composition? Is Applicant intending to claim the form of the paper product by reciting “towels, wipes and napkins”?

(v) The phrase “said water-soluble skin conditioning component including glycerin” in claims 1 (part (ii)), 22 (part (ii)), 30 (part (ii)) is vague and indefinite, as it is confusing. Is glycerin in addition to the water-soluble skin-conditioning component or is it the water-soluble skin-conditioning component?

(vi) The phrase “said viscosity modifier component including a surfactant” in claims 1 (part (iii)), 22 (part (iii)), 30 (part (iii)) is vague and indefinite, as it is confusing. Is the surfactant in addition to the viscosity modifier component or is it the viscosity modifier component?

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(vii) The phrases “water-soluble skin conditioning component”, “viscosity modifier component”, and “liquid-coupling component” in claims 1 (part (ii), (iii), (iv)), 3 (lines 1-2), 4 (lines 1-2), 7 (lines 1-2), 9 (lines 1-2), 11 (lines 1-2), 12 (line 2), 13 (lines 1-2), 22 (part (ii), (iii), (iv)), 24 (lines 1-2), 25 (lines 1-2), 30 (part (ii), (iii), (iv)), 34 (lines 1-2), 35 (lines 1-2), 36 (lines 1-2), 37 (line 2), 38 (lines 1-2), 44 (line 2), 45 (line 2), 46 (lines 1-2), are vague and indefinite, as it is not clear whether these phrases refer to a single component or if these phrases are referring to a mixture of components. Is not a component a single entity?

(viii) The term “secondary fibers” in claims 47-49 is vague and indefinite, as it is not clear what fibers are being differentiated by the description “secondary”. Is a secondary fiber a fiber that is not the main fiber in the mixture? Is the secondary fiber a lesser quality fiber? What is a secondary fiber?

(ix) The phrase “in an amount between about between” in claim 22 (part (ii)), is vague and indefinite, as the percent weight range is not clear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-11, 13-17, 19-22, 24-27, 29, 47, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rourke et al. (6,207,596).

Rourke et al. teach a disposable wipe which comprises a substrate, an antimicrobial protease inhibitor, and a liquid. The wipe may optionally include other ingredients such as

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humectants, emollients, surfactants, fragrances, emulsifiers, and preservatives. Glycerin, sorbitol, propylene glycol and mixtures thereof are disclosed as humectants, wherein the humectants comprise 0.5-10% of the composition. Preservatives are disclosed as optional ingredients comprising 0.005-0.5% of the composition. The substrate is disclosed as comprising woven or nonwoven natural fibers, synthetic fibers, or mixtures thereof. The reference lacks exemplification of the instant absorbent paper product, preferred percent weights. See Col. 3, lines 35-52; Col. 5, line 50-Col. 6, line 63; Col. 7, line 22-line 47; Col. 12, line 58-Col. 16, line 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the absorbent paper product of the instant invention using the teachings of Rourke et al. because a) Rourke et al. teach disposable wipes comprising an antimicrobial active agent, a substrate, and a liquid, wherein emollients that increase the viscosity of compositions and humectants, such as glycerin, can be added to the wipes; and b) Rourke et al. teach that humectants such as glycerin hydrate the skin and that emollients moisturize the skin; thus, one of ordinary skill in the art would be motivated to exemplify the wipes of Rourke et al., wherein glycerin and viscosity increasing emollients are added because of the expectation of hydrating and moisturizing the skin.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to teach the lotion as comprising 1-10% of the paper product, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 UPQ 233.

Claims 1, 12, 22, 44, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable

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over Rourke et al. in view of Sebillotte-Arnaud (5,728,389).

Rourke et al. is applied as discussed above. The reference lacks preferred surfactants.

Sebillotte-Arnaud teach compositions for cleaning the skin. Disclosed is a composition wherein talloweth-60 myristyl glycol is disclosed as a non-ionic surfactant. See Col. 1, lines 10-50; Col. 6, line 40-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the non-ionic surfactant of Rourke et al. as the talloweth-60 myristyl glycol of Sebillotte-Arnaud because a) Rourke et al. and Sebillotte-Arnaud are both directed to cosmetic compositions that impart benefit to the skin; b) Sebillotte-Arnaud teach talloweth-60 myristyl glycol as a safe and effective non-ionic surfactant for use on the skin.

Claims 30-36, 38-43 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rourke et al. in view of Wendt et al. (6,017,417) in further view of Vlasblom (WO 99/41068).

Rourke et al. is applied as discussed above. The reference lacks a method of making the paper product.

Wendt et al. teach a method of making soft tissue products, wherein the tissue is made by forming a web from a furnish containing fibers and water, and through-drying the web to remove the water. See abstract; Col. 24, line 10-Col. 34, line 3.

Vlasblom teaches cleaner impregnated towels. A method of making the cleaner towels is disclosed, wherein the substrate (towel) is sprayed with the cleaner formulation or conveyed through a wetting vat of the cleaner formulation. See pg. 9, line 10-pg. 19.

It would have been obvious to one of ordinary skill in the art at the time the invention

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was made to teach the wipe of Rourke et al. as formed by the method of Wendt et al. because a) Wendt et al. teach forming webs from a furnish containing fibers and water, and through-drying the web to make paper products as well known in the art; b) Wendt et al. teach his method as increasing the bulk, absorbent capacity, absorbent rate and flexibility of the paper product.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to spray the composition of the combined references onto the paper web, as taught by Vlasblom because a) Vlasblom and the combined references teach a web of non-woven materials as impregnated with a cosmetic composition for application to the skin; b) Vlasblom teaches spraying the composition onto the non-woven material as a standard process, wherein the web is effectively impregnated with solution.

Claims 30, 37, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rourke et al. in view of Wendt et al. in further view of Sebillotte-Arnaud.

Rourke et al. is applied as discussed above. The reference lacks preferred surfactants.

Wendt et al. is applied as discussed above.

Sebillotte-Arnaud is applied as discussed above.

Rourke et al. and Wendt et al. are combined as discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the non-ionic surfactant of the combined references as the talloweth-60 myristyl glycol of Sebillotte-Arnaud because a) the combined references and Sebillotte-Arnaud are directed to cosmetic compositions that impart benefit to the skin; b) Sebillotte-Arnaud teach talloweth-60 myristyl glycol as a safe and effective non-ionic surfactant for use on the skin.

Unexpected Results

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, the data on pages 17-29 of the specification have been considered but not found persuasive because the data merely demonstrate the effectiveness of the instant composition in imparting benefit to the skin. This is seen to be an expected result based on the cited prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this

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final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
May 29, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200